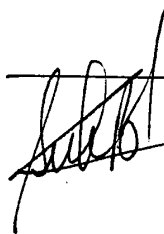


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In the Claims:

Please amend claim 34 as follows:

 34. (Amended) An electronic file tracking system comprising:

[a database for maintaining file identity, file location, and unique file addresses for a plurality of files;]

a processor for issuing control signals;

a folder retainer having electrical contacts communicatively coupled to said processor;

 and

a plurality of file folders, each file folder including an addressable device adapted to be electrically coupled to said bus when the file folder is placed in said folder retainer, and a conductor located on said file folder and configured so as to electrically couple said addressable device to the electrical contacts of said folder retainer when said file folder is positioned in any one of several different positions.

REMARKS

In the Office Action, the Examiner grouped the claims into eight groups and required Applicants to elect one of those groups for further prosecution. Applicants hereby elect to pursue the invention defined in Group VII. As indicated in the chart on page 5 of the Office Action, Group VII shall include claims 1, 12, 13, 19, 23, and 34-38. Per the recent

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interview with the Examiner, Group VII further includes independent claim 54. Applicants make this election with traverse, as will be apparent from the comments below.

This application is a continuation of U.S. Patent Application No. 08/379,944. In the parent application, a six-way restriction was made. After convincing the Examiner to join two of the identified groups, Applicants elected and prosecuted the two rejoined groups. Having obtained allowance of some of the claims of the two elected groups in the parent application, Applicants cancelled the rejected claims from the parent application and presented those cancelled claims in this application for further prosecution. Thus, the claims presented in this application were previously all in one restricted group, upon which several Office Actions on the merits had been mailed. The Examiner now, however, is requiring restriction of these claims into eight different groups.

In the restriction requirement, the Examiner stated that the inventions defined in Groups IV, V, VI, and VII are species groups of the retainer used in a file locator system. For such a restriction to be proper, it is incumbent upon the Examiner to show that each of the species claims define characteristics of the invention that are mutually exclusive of one of the characteristics defined in the other species claims. MPEP §806.04(e) defines "species" as follows:

*Species are always the specifically different embodiments.*

Species are *usually* but not always independent as disclosed (see MPEP §806.04(b)) since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments,

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where the case under consideration contains no disclosure of any commonality of operation, function or effect.

Most significantly, MPEP §804.04(f) states:

Claims to be restricted to different species *must be mutually exclusive*. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that the claims to be restricted to different species, must recite the mutually exclusive characteristics of such species.

As explained below, the alleged "species" claims restricted into different groups do not define mutually exclusive characteristics of the invention. In fact, the specification clearly teaches that all the recited characteristics may be found in a single system constructed in accordance with the present invention. Fig. 1 clearly shows a system including most, if not all, of the different types of disclosed folder retainers that may be used in the inventive system.

With respect to the inventions defined in Groups IV through VII, the Examiner has indicated that claims 12, 13, and 54 are generic to those species claims. Of particular interest is claim 54, which recites a file tracking system comprising a *plurality* of folder retainers. As clearly disclosed in the application and hence recited in dependent claims 55-60, which correspond to Groups IV through VI, only one of the plurality of folder retainers needs to be particular type of folder retainer. Specifically, the system having a plurality of folder retainers may include a shelf, file cabinet, and file tray as clearly shown in Fig. 1. Because each of these "species" may be used together in a single embodiment, the different

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types of folder retainers do not define mutually exclusive characteristics of the system. Since the different types of folder retainers disclosed and claimed in this application are not mutually exclusive of one another, Applicants submit that a restriction between these different types of folder retainers is clearly improper and the restriction requirement therebetween should be withdrawn.

In the restriction requirement, the Examiner also stated that the inventions defined in Groups I, II, III, and VIII are related as subcombinations disclosed as useable together in a single combination. The Examiner contends that the subcombinations are distinct from each other because they have separate utility from one another, insofar as they may be separately implemented in the disclosed system. It is noted, however, that MPEP §806.05(d) states that the Examiner must show that each one of the subcombinations has utility other than in *the disclosed combination*. Thus, the separate utility is not shown relative to each of the subcombinations but rather to the combination. In making the restriction requirement, the Examiner did not provide any examples of where the alleged subcombinations may be used apart from the disclosed combination. With the rationale used by the Examiner, virtually all dependent claims could be restricted from one another.

MPEP §806.05(d) further states:

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by *both* the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (MPEP §806.04(b)). [Emphasis added]

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Claims 1, 19, and 23 are clearly generic to the claims included in Groups I, II, III, and VIII. Because the Examiner has indicated that claims 1, 19, and 23 are included in each group, the Examiner has effectively admitted that claims 1, 19, and 23 are generic.

Therefore, MPEP §806.05(d) requires that the restriction must also be proper under genus-species practice. As explained above, to be proper under genus-species practice, the claims must include limitations covering mutually exclusive characteristics of each of the different species. The limitations recited in each of the different "species" claims, however, do not define mutually exclusive characteristics of the different species. Therefore, the requirements of genus-species practice have not been met, and the restriction is improper and must be withdrawn.

In the Office Action, the Examiner has not indicated why any one of Groups IV through VII define distinct inventions from any one of Groups I through III and VIII or vice versa. To the extent Applicants have elected Group VII, Applicants ask that the Examiner provide the basis as to why each of remaining Groups I through III and VIII defines a patentably distinct invention from that defined in elected Group VII. It is not clear, for example, how Groups III and VIII can be considered to be patentably distinct from Group VII when claims 39 through 41 of Group III and claim 42 of Group VIII depend directly from claims in Group VII (*i.e.*, claims 34 and 38). Claims 39 through 41 cannot be considered to define mutually exclusive features from those defined in claim 38 since they incorporate all the limitations of claim 38. Similarly, claims 39 through 41 cannot be related to claim 38 as a restrictable combination/subcombination. Thus, if claim 34 were allowed,

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claims 39 through 42 would also be allowable, and Groups III and VIII should then be regrouped with Group VII.

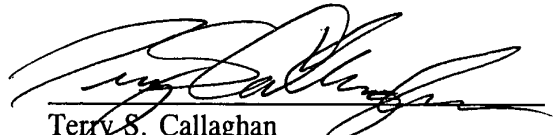
In view of the foregoing remarks, Applicants respectfully submit that the basis for imposing this restriction requirement improper, and all the claims should be grouped together. In any event, if any of claims 1, 19, or 23 are allowed, all the groups should be regrouped since the Examiner has indicated that claims 1, 19, and 23 are generic to all the groups.

Respectfully submitted,

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